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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,595	11/13/2000	Mamoru Shinohara	09792909-4686	7924

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EXAMINER

AHMED, SAMIR ANWAR

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/711,595

Applicant(s)

SHINOHARA, MAMORU

Examiner

Samir A. Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.                      6) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

1. Figures 4, 5A and 5B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to under 37 CFR 1.83(a) because Fig. 2 fails to show "the static electricity drawing wiring 401 protrudes from the fingerprint recognizing surface upwardly" as described in the specification on page 19, lines 14-18. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claims 1-10 are objected to because of the following informalities: in claim 1, line 6, "first electrodes" should be changed to --first electrode -- and in claim 4, line 2, "second electrodes" should be changed to --second electrode --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2, 8, 12, 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 2 recites "said second surface is substantially equivalent to a surface of said insulating film", lines 1-2. There is no disclosure in the specification that the surface of the static electricity drawing wiring (second surface) is substantially equivalent to a surface of said insulating film nor how to perform it.

As to claims 8, 12, 18 refer to claim 2 rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al. (U.S. Patent 6,326,227).

As to claim 1, Thomas discloses a semiconductor apparatus, comprising:

a substrate having a transistor (col. 6, lines 34-42, Fig.2, item 18);

a first electrode formed on said substrate and connected to said transistor (Figs. 2 and 5, item 10 or 12);

a second electrode formed on said substrate and electrically separated from said first electrodes (Fig. 5, item 32); and

an insulating film formed on said substrate so as to cover said first electrode (Fig. 5, items 16),

wherein, when a plane of said insulating film which is not on a side of said substrate is taken as a first plane, a surface facing said first plane of said first electrode is taken as a first surface [in Fig. 5, the top surface of the insulating layer 16 is not on the side of the substrate 13 and is taken as a first plane, the top surface of electrode 10 or 12 (first electrode) facing the first surface and is a first surface], and a surface facing said first plane of said second electrode is taken as a second surface [in Fig. 5, the surface of grid 32 (second electrode) facing the first surface and is a second surface] , a distance between a surface of said substrate and said second surface is larger than a distance between the surface of said substrate and said first surface [ Fig. 5 shows that the distance between the surface of the electrode 32 (second surface) and the surface of substrate 13 is larger than the distance between the surface of electrode 10 or 12 (first surface) and the surface of substrate 13 because the grid 32 is disposed on the top of the insulating layer at a different plane from that of electrodes 10 or 12 (col. 7, lines 1-9, lines 27-28).

as to claim 2, Thomas further discloses, wherein said second surface is substantially equivalent to a surface of said insulating film [the surface of grid 32

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(second surface) is integrated with the insulating layer 16 (substantially equivalent) (col. 7, lines 27-28, Fig. 5)].

As to claim 3, Thomas further discloses, wherein the distance between the surface of said substrate and said second surface is larger than a distance between the surface of said substrate and the surface of said insulating film [Fig. 5, shows that the distance between the surface of the electrode 32 (second surface) and the surface of substrate 13 is larger than the distance between the surface of substrate 13 and the surface of the insulating layer 16].

As to claim 4, Thomas further discloses, wherein said second electrodes is fixed in a constant potential [grid electrode 32 (second electrode) is connected to the ground (col. 7, lines 13-14), i.e. fixed in a zero potential (constant potential)].

As to claim 5, Thomas further discloses, wherein a plurality of said first electrodes are arranged in a matrix form, and said second electrode is disposed between said plurality of first electrodes (col. 7, lines 1-15, Fig. 5, items 10, 12, and 32).

As to claim 6, Thomas further discloses, wherein a plurality of said second electrodes are arranged in a matrix form col. 7, lines 1-15, Fig. 5, items 10, 12, and 32).

As to claim 7, Thomas further discloses, wherein said first electrode is connected to a first terminal of said transistor [Fig. 2, amplifier 18a (transistor) connected to electrode 12 (first electrode)], and a second terminal of said transistor is connected to a bit line and a capacitance element to which a potential is applied [Fig. 2, amplifier 18a (transistor) connected to capacitor 20a and VREF (potential), the line connection is a bit line].

As to claim 8, Thomas further discloses, wherein said second electrode is fixed in a constant potential [grid electrode 32 (second electrode) is connected to the ground (col. 7, lines 13-14), i.e. fixed in a zero potential (constant potential)].

As to claim 9, refer to claim 8 rejection.

As to claim 10, Thomas further discloses, wherein said second electrode is electrically connected to a pad electrode which is connected to a lead for taking a signal out [the topographic discharge grid 32 is connected to a charge dissipation circuit has a conductive path (pad electrode) to ground in order to dissipate electrostatic charges to ground (taking a signal out) (col. 6, lines 4-12,col. 7, 13-15, col. 7, line 65-col. 8, line 3) and a connection (lead) to the ground is inherited otherwise the dissipated charge cannot reach the ground].

As to claim 11, refer to claim 1 rejection. Thomas further discloses a silicon (semiconductor) substrate (col. 4, line 66) and in Fig. 5, the top surface of the insulating layer 16 is the plane on which the fingerprint is placed (see fig. 2, finger 22).

As to claim 12, refer to claim 2 rejection.

As to claim 13, refer to claim 3 rejection.

As to claim 14, refer to claim 4 rejection.

As to claim 15, refer to claim 5 rejection.

As to claim 16, refer to claim 6 rejection.

As to claim 17, refer to claim 7 rejection.

As to claim 18, refer to claim 8 rejection.

As to claim 19, refer to claim 9 rejection.

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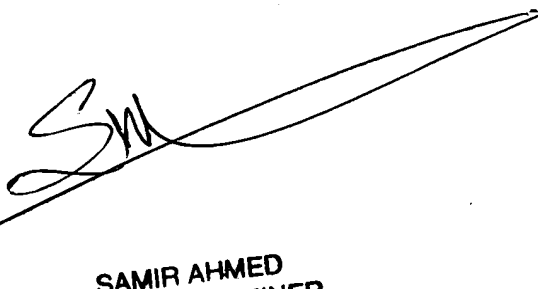
As to claim 20, refer to claim 10 rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir A. Ahmed whose telephone number is 703-305-9870. The examiner can normally be reached on Mon-Fri 8:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-303-3900.

SA

A handwritten signature in black ink, appearing to be 'SA' followed by a long, sweeping horizontal line that extends to the right.

**SAMIR AHMED**  
**PRIMARY EXAMINER**